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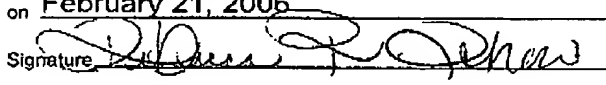
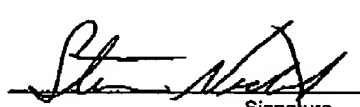
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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  40000-0011	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>February 21, 2006</u> Signature <u></u> Typed or printed name <u>Rebecca R. Schow</u>		Application Number <b>09/826,198</b> Filed <b>April 4, 2001</b> First Named Inventor <b>David H. Bessel</b> Art Unit <b>2611</b> Examiner <b>LAMBRECHT, Christopher M.</b>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,326</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u></u> Signature <u>Steven L. Nichols</u> Typed or printed name <u>(801) 572-8066</u> Telephone number <u>February 21, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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REMARKS

The sole issue in this application is whether Applicant has successfully antedated the single applied prior art reference under 37 C.F.R. § 1.131. Applicant has filed several declarations under 37 C.F.R. § 1.131 and 1.132 to make of record those facts that show complete invention prior to the filing date of U.S. Patent Application Publication 20040261112 to Hicks et al. ("Hicks").

In the Advisory Action of 8 February 2006, the Examiner held the previous declarations to be ineffective under 37 C.F.R. § 1.131 as not evidencing a reduction to practice. Applicant respectfully disagrees.

ACTUAL REDUCTION TO PRACTICE:

"Reduction to practice" means that the invention has been taken beyond a mere conception and is rendered in sufficient detail that one of skill in the art may make and use the invention without undue experimentation. This is why an enabling disclosure under 35 U.S.C. § 112, filed as a patent application, can serve as a "constructive" reduction to practice.

An actual reduction to practice can clearly be demonstrated by producing a working prototype. However, the patent law also recognizes that some inventions can be described clearly enough on paper, as in a blue print, the one of skill in the art is then able to make and use that invention. Consequently, the construction of the invention on paper brings the invention beyond a mere conception and constitutes a reduction of the invention to practice. (See MPEP 715.07(III) citing *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931) (These cases

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hold that such evidence as pictures of the invention, coupled a technical report describing the invention are sufficient to show reduction to practice).

In the instant case, the Applicant has made of record a document dated September 22, 2000. *See* Declaration under 37 C.F.R. § 1.131 filed January 19, 2006. This document contains both figures illustrating the invention as well as a written technical description. It is clearly evident from this document that one of skill in the art could have, with the document, been enabled to make and use the invention without undue experimentation. Consequently, this document represents an actual reduction to practice of the invention claimed in this application prior to the filing of the Hicks reference.

Specifically, claim 1 of the instant application presently recites:

A television signal processing and recording system for handling both digital and analog video signals, said system comprising:  
a video decoder in an analog signal path for converting an analog signal to a digital signal;  
an encoder for compressing said digital signal output by said video decoder;  
and  
a connection for routing said compressed digital signal into a digital signal path in which said compressed digital signal is selectively either decompressed with a decoder and output to a television set or recorded on a digital data storage device.

This subject matter is disclosed and described in the disclosure document of September 22, 2000 in sufficient detail so as to enable practice of the invention as here claimed. Specifically, referring to Figure 2 of the disclosure document an analog signal path ("Analog Video") is shown that incorporates a video decoder ("Video Decoder") for converting an analog signal ("Analog Video") into a digital signal. An encoder ("MPEG2 Encoder") is also illustrated for compressing the digital signal output by the video decoder ("Video Decoder"). Figure 2 also shows a connection for routing the compressed digital signal into a digital signal path ("Digital Video," "DeMuxx") where the compressed digital signal is selectively decompressed with a decoder ("MPEG2 Decoder") or output to a digital data storage device ("PVR Hard Disk Drive"). This subject matter is further described and

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enabled to one of skill in the art in the text accompanying and describing Figure 2 of the disclosure document.

As further evidence that this disclosure document represents an effective reduction to practice, the disclosure document was almost exclusively by the undersigned to prepared the instant patent application which has been held to be an enabling disclosure of the invention. The figures of the disclosure document dated September 22, 2000 clearly form the basis for the figures of the instant patent application.

Consequently, Applicant had both conceived of and provided a written reduction to practice of the invention at least as early as September 22, 2000. For these reasons, Applicant's declarations under 37 C.F.R. § 1.131 should be held effective and the Hicks reference removed from consideration as prior art against the instant patent application.

Constructive Reduction to Practice:

In the alternative, the Advisory Action of 8 February 2006 holds that the disclosure document of September 22, 2000 evidences conception of the invention. The instant patent application, which undisputedly represents a *constructive* reduction to practice, was filed April 4, 2001. Between September 22, 2000 and April 4, 2001, the Applicant worked diligently toward the filing of the instant application, i.e., the constructive reduction to practice.

The Applicant was an employee of Sony Electronics, Inc. ("Sony") at the time the invention was made. Consequently, consistent with applicable employment agreements, the Applicant prepared the disclosure document of September 22, 2000 and submitted it to the intellectual property department of Sony as evidenced by the "received" stamps on the

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disclosure document of September 22, 2000 which was submitted with the Declaration of January 19, 2006.

The disclosure document was then reviewed in October 2000 along with the many other disclosures generated by inventors at Sony. This prompt review of the invention evidenced its value, and the decision was made to pursue the filing of a patent application. Accordingly, a prior art search was requested on November 9, 2000 from the firm of Mooreland and Moore, Inc. in Arlington, Virginia. The results of this search were received December 8, 2000 along with a statement that "no references were found to disclose the immediate objects of the instant invention."

Applicant and Sony then conducted a review the results of the search report. Following this review, the decision was made to proceed with the present patent application. On January 24, 2001, the disclosure document of September 22, 2000 was provided by Sony to the undersigned with instructions to prepare the instant patent application. The undersigned hereby declares under 35 U.S.C. § 1.132 that the application was then diligently prepared consistent with the demands of other client projects. The instant application was then filed a little over two months later on April 4, 2001.

These facts, now of record, illustrate conception of the invention prior to the filing of the Hicks reference and diligent activity in pursuit of the invention from the date of conception to the filing of the instant patent application. For these alternative reasons, the Hicks reference should be removed from consideration as prior art against the present application.